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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,882	05/17/2006	Dominique Jean-Pierre Mabire	PRD-2124USPCT	8486
27777 7590 04/21/2009 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER BAEK, BONG-SOOK				
ART UNIT		PAPER NUMBER		
1614				
MAIL DATE		DELIVERY MODE		
04/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/595,882

**Applicant(s)**

MABIRE ET AL.

**Examiner**

BONG-SOOK BAEK

**Art Unit**

1614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8 and 10-30 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10-13 and 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 14-16, and 29-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **Detailed Action**

### ***Status of claims***

The amendment filed on February 4, 2009 is acknowledged. Claims 5, 7, and 9 have previously been canceled. Claims 1-4, 6, 14-16, and 29-30 are under examination in the instant office action.

Applicants' arguments, filed on February 4, 2009, have been fully considered but they are moot in view of new ground of rejection, which is necessitated by Applicants' amendment (exclusion of a species to overcome the rejection). Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application. Responses are limited to Applicants' arguments relevant to either reiterated or newly applied rejections.

### ***Claim Objection***

Claims 29-30 are objected as being dependent from the non-elected group.

### ***35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 6, 14-15, and 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. All the dependent claims are included.

Claim 1 is amended to exclude 7-benzoyl-3-methyl-2-(1H)-quinoxalinone to overcome the rejection over Ali *et al.* However, the original application provides no support for excluding that species. Therefore, it is considered as new matter.

New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

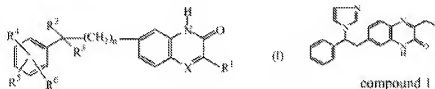
invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

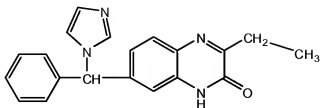
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 6, 14-16, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,028,606 in view of US 6,583,144 (Issue: 6/24/2003).

The instant invention is drawn to a compound of the following formula (I) and a pharmaceutical composition comprising the compound of formula (I) and the following compound is recited in the instant claim 4.



US 5,028,606 teaches substituted quinoxalinone derivatives (abstract and Table 9) and disclose the following compound (Table 9, compound 115):

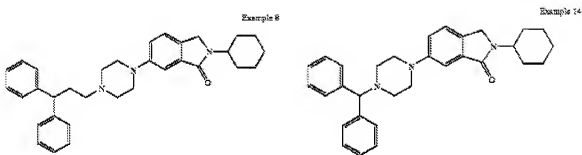


The reference also teaches a pharmaceutical composition of substituted quinoxalinone derivatives with a pharmaceutically acceptable carrier (column 20, lines 47-58).

With regard to the instant claims 29-30, which are directed to a product made by the process of the instant claim 13, the reference discloses the same processes of making the substituted quinoxalinone derivatives as recited in the instant claim 13 (column 8, line 61- column 9, line 23 and column 10, lines 37-65). In the alternative, when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process, either 102 or 103 rejection can be properly made. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP §2113. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The difference between the instant compound (compound 1) and that of the prior art is that the instant compound has ethyl groups instead of methyl groups in the position 7 of quinoxalinone ring.

US 6,583,144 teach the following compounds (column 69, example 8 and column 71, example 14), which shows that both compounds with and without the addition of CH<sub>2</sub> group (a linker group) retain the same biological activity:



It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to modify the compound taught by US 5,028,066 to arrive at the claimed compound in the field of medicinal chemistry as evidenced by US 6,583,144. In addition, a *prima facie* case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). Notably, the only difference between the prior art and the claimed compound is the addition of a single CH<sub>2</sub> group to the prior art Compound 115 taught by US 5,028,066. However, as noted above, compounds differing by the addition of one CH<sub>2</sub> group are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. Accordingly, in view of *In re Payne* and US 6,583,144, the skilled artisan would have been motivated to make the claimed compound in order to make a similar compound with the expectation that it would have similar properties to that taught by the prior art with a reasonable expectation of success.

***Provisional Double Patenting Rejection***

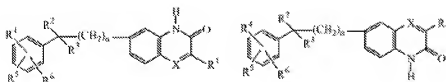
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

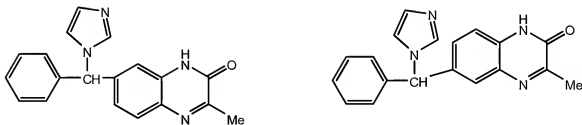
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



Claims 1-4, 6, 14-16, and 29-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 7 of copending Application No. 10/595891 in view of US 5,028,606. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to substituted quinolinone and quinoxaline compounds of the almost identical structure and the same substitutions. The difference between the instant compounds and the compounds of the '891 application is the position of the substitution (position 7 for the instant application and position 6 for the '891 application) as shown below:



As stated in the first 102 rejection above, US 5,028,606 teaches the same compounds as the instant invention. It further shows that position isomers, which have a substitution in the either position 6 or position 7 of quinoxaline ring, are possible while retaining the same biological activity. The following is an example of positional isomers shown in US 5,028,606.



It would have been obvious to a person of ordinary skill in the art at the time the invention was made to change substitution position to get another positional isomer with a reasonable expectation of success since US 5,028,606 already suggests making positional

isomers of the same core structure as the instant invention in the same positions while retaining the same biological activity. One skilled in the art would have been motivated to prepare positional isomers as taught by the prior art with the expectation of obtaining another homologous compound which will retain the same activity.

This is a provisional obviousness-type double patenting rejection.

Since a terminal disclaimer has not been filed, the above double patenting rejection is maintained.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BONG-SOOK BAEK whose telephone number is 571-270-5863. The examiner can normally be reached 9:00-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian-Yong S Kwon/  
Primary Examiner, Art Unit 1614  
Bbs

BONG-SOOK BAEK  
Examiner, Art Unit 1614